

### REMARKS

This responds to the Office Action mailed on April 1, 2004.

Claims 2, 17-19, 21-22, 25 and 27-28 have been amended. Claims 2-3, 5, 9 and 12-29 are pending in this application.

The amendments to the claims are made to satisfy Applicant's preferences, not necessarily to satisfy any legal requirement(s) of the patent laws, and they are not intended to limit the scope of equivalents to which any claim element may be entitled.

#### §103 Rejection Of The Claims

Claims 2, 3, 5, 9 and 12-29 were rejected under 35 USC §103(a) as being unpatentable over Graham-Cummings, Jr. (U.S. 6,182,146) in view of "Applicant's Admitted Prior Art" (AAPA). Applicant respectfully traverses this rejection.

Applicant does not admit that Graham is prior art, and reserves the right to challenge Graham as prior art. Nevertheless, Applicant respectfully submits that the rejection fails to make a *prima facie* case of obviousness as set forth below.

The Office Action has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that, the Office Action must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The Examiner is required to make specific findings on a suggestion to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999). Applicant respectfully asserts that the Action does not show an objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art, which would lead an individual to combine the relevant teaching of the references.

(A) The Action Does Not Show That The Claimed Combination Is Suggested

Each of independent claims 2, 12, and 23 recite an element that is not found in Graham. Specifically, independent claim 2 recites in part “when there is a host application assigned to the port number, sending a wake-up message to a host computer;” independent claim 12 recites in part “when there is a host application associated with the port number, sending a wake-up message to a host computer;” and independent claim 23 recites in part “send a wake-up message to a host computer when there is a host application associated with the port number.”

The Office Action noted that Graham does not expressly disclose “sending a wake-up message to a host computer.” Instead, the Action looks to AAPA and states on page 4 of the Action:

*it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Graham to reduce power by putting the host computer to sleep then sending a wakeup message when there is a host application assigned to the port corresponding to the packet. One of ordinary skill in the art would have made the modification because this would allow power consumption to be reduced while still being able to respond only to an appropriate packet, which is desirable in Graham.*

The mere fact that a prior art reference could be modified in the manner proposed by the Examiner does not make such modification obvious, unless the prior art suggests the desirability of doing so. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Applicant respectfully submits that the Office Action does not make out a *prima facie* case of obviousness because it provides no evidence of a suggestion to combine the Graham and AAPA. Applicant respectfully requests that the Examiner point out the column and line number in Graham where the motivation is found to combine Graham with AAPA.

Accordingly, because the Action does not show that there is some suggestion or motivation found in Graham to combine Graham and AAPA, the Office Action has not established a *prima facie* case of obviousness for independent claims 2, 12, and 23. MPEP §2143 and M.P.E.P. §2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

(B) The Action May Not Use Improper Hindsight To Establish Obviousness

The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). “Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor.” *Para-Ordnance Mfg., Inc. v. SGS Importers Int’l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), *cert. denied*, 117 S.Ct. 80 (1996) citing *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13, *cert. denied*, 469 U.S. 851 (1984).

Applicant respectfully submits that the Office Action has not provided evidence from Graham for a suggestion or motivation to combine Graham and AAPA. If the Action relied on Applicant’s disclosure to suggest the claimed combination, the Action has fallen victim to “the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313, *cert. denied*, 469 U.S. 851 (1984). Accordingly, because the Action does not show that there is some suggestion or motivation to combine Graham and AAPA found in Graham, and not from Applicant’s specification, nor from impermissible hindsight, the Office Action has not established a *prima facie* case of obviousness for independent claims 2, 12, and 23. MPEP §2143 and M.P.E.P. §2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

(C) The Action Does Not Show Some Knowledge Generally Available To One Of Ordinary Skill In The Art That Would Lead An Individual To Combine Graham And AAPA

Applicant respectfully asserts that the Action does not show some knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the relevant teaching of the references.

The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which indicates that the motivation must be supported by evidence in the record. There is no evidence in the record to support such a combination, as discussed above. This use of unsupported assertions does not satisfy the explicit requirements set forth by the *In re Sang Su Lee* court. Thus, the Examiner appears to be using

---

personal knowledge, and the Examiner is thus respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

If the Examiner cannot provide an affidavit, Applicant requests withdrawal of the rejection and reconsideration and allowance of the claims.

It is therefore respectfully requested that the rejections to independent claims 2, 12, and 23 under 35 U.S.C. §103 be reconsidered and withdrawn.

*Dependent Claims*

Claims 3, 5, 9, 13-22, and 24-29 depend, directly or indirectly, from independent claims 2, 12, or 23 and incorporate all of the limitations of the claim(s) from which they depend. Accordingly, dependent claims 3, 5, 9, 13-22, and 24-29 are also asserted to be allowable for the reasons presented above, and Applicant respectfully requests notification of same.

*Additional Elements And Limitations*

Applicant considers additional elements and limitations of claims 2, 3, 5, 9, and 12-29 to further distinguish over the cited references, and Applicant reserves the right to present arguments to this effect at a later date.

AMENDMENT UNDER 37 C.F.R. 1.116 – EXPEDITED PROCEDURE

Serial Number: 09/746205

Filing Date: December 22, 2000

Title: PORT-BASED PACKET FILTER

Assignee: Intel Corporation

Page 10

Dkt: 884.336US1 (INTEL)

Conclusion

Applicant respectfully submits that claims 2, 3, 5, 9, and 12-29 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Lucinda Price (located in Gainesville, Florida), at (352) 373-8804, or Applicant's below-named representative (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

CHARLES L. BRABENAC

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
Attorneys for Intel Corporation  
P.O. Box 2938  
Minneapolis, Minnesota 55402  
(612) 349-9592

Date June 1, 2004

By Ann M. McCrackin  
Ann M. McCrackin  
Reg. No. 42,858

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 1st day of June, 2004.

KACIA LEE  
Name

Kacia Lee  
Signature